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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Guoqing Cao

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PATENT DIVISION

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

04/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,649	<b>Applicant(s)</b> CAO ET AL.	
	<b>Examiner</b> Brenda L. Coleman	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,9,12,14-16,18,20,22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,9,12,14-16,18,20,22 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/2009; 3/30/2006; &amp; 8/24/2006</u> .                    | 6) <input type="checkbox"/> Other: _____                          |



### **DETAILED ACTION**

Claims 1-5, 8, 9, 12, 14-16, 18, 20, 22 and 26 are pending in the application.

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on February 2, 2009 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Such a utility cannot be deemed enabled.

Pursuant to *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), one considers the following factors to determine whether undue experimentation is required: (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H). The quantity of experimentation needed to make or use the invention based on the content of the disclosure. Some experimentation is not fatal; the issue is whether the amount of experimentation is "undue"; see *In re Vaeck*, 20

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USPQ2d 1438, 1444.

The analysis is as follows:

(A) Breadth of claims.

(a) Scope of the compounds. The instant claims encompass millions of compounds with a 2,3,4,5-tetrahydrobenzo[b]azepine scaffold with a variety of substituents at various positions.

(b) Scope of the diseases covered. The instant claims are drawn to a method of treating any and all cardiovascular disorders. Cardiovascular disorders embrace a vast array of problems, some of which are contradictory to others. This covers various forms of endocarditis, including verrucous, atypical verrucous (Libman-Sacks) Non-bacterial thrombotic - NBTE (marantic), bacterial, viral, and rickettsial endocarditis. It covers different forms of atresia, including tricuspid atresia without TGV, pulmonic valvular atresia and aortic atresia. It includes assorted cardiomyopathies, including restrictive cardiomyopathy, peripartum cardiomyopathy, hypertrophic cardiomyopathy, and congenital cardiomyopathy. It embraces various forms of aortic Stenosis, including valvular aortic Stenosis, idiopathic hypertrophic sub-aortic stenosis (IHSS), subvalvular aortic stenosis, and supravalvular aortic stenosis. There are all kinds of miscellaneous syndromes, including subclavian steal syndrome, Eisenmenger syndrome, mitral valve prolapse (Barlow) syndrome, Aortic arch syndrome, scimitar syndrome, hypoplastic left heart syndrome, Lutembacher syndrome, and superior vena cava syndrome. It covers various forms of hypertension, including

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primary (idiopathic) pulmonary hypertension, neonatal pulmonary venous hypertension and pulmonary hypertension. It includes aortic aneurysms, including both thoracic and abdominal, as well as mycotic aneurysm. It covers various types of arrhythmias and atrial fibrillation. It covers elevated blood levels of triglycerides, of total cholesterol or of LDL cholesterol, and hyperlipoproteinaemias. It covers different forms of ischaemic heart disease including congestive heart failure and myocardial infarction. It covers a vast array of structural defects such as atrial septal defect (ASD), aortopulmonary window, egg-on-its-side heart, gooseneck deformity, endocardial cushion defect, arc of Buehler, arc of Riordan, truncus arteriosus, Ebstein's Malformation, azygos continuation of interrupted IVC, Atrioventricular Canal, ventricular septal defect (VSD), abdominal aortic coarctation, aortic pseudo-coarctation, complete endocardial cushion defect, Hypoplastic Left Heart, patent ductus arteriosus (PDA), congenital absence of pulmonary valve, aortic coarctation partial endocardial cushion defect, Single Ventricle, box-like heart, pulmonary sling, Left Ventricle to Right Atrial Shunt, total anomalous pulmonary venous return (TAPVR), partial anomalous pulmonary venous return (PAPVR), and transposition of the great vessels. It covers certain peripheral vascular disorders, such as deep-vein thrombosis and thrombophlebitis and assorted cerebral vascular diseases including migraine. There is hypotension, which can arise from all sorts of other problems. There are a number of different forms of vasculitis, including Churg-Strauss vasculitis, consecutive vasculitis,

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granulomatous vasculitis of central nervous system, hypersensitivity vasculitis, (called also allergic or leukocytoclastic vasculitis or leukocytoclastic angiitis which arises from hypersensitivity to an antigenic stimulus), hypocomplementemic vasculitis, isolated vasculitis of central nervous system, nodular vasculitis, overlap vasculitis (polyangiitis overlap syndrome), pulmonary vasculitis including Wegener's granulomatosis, rheumatoid vasculitis, segmented hyalinizing vasculitis (livedo vasculitis), Polyarteritis nodosa, and urticarial vasculitis. There are also specific forms of arteritis, including coronary arteritis, equine viral arteritis, giant cell arteritis (cranial, granulomatous, or temporal arteritis or Horton's disease), infantile arteritis, infectious arteritis, arteritis obliterans (endarteritis obliterans), rheumatic arteritis, syphilitic arteritis, Takayasu's arteritis (aortic arch, or brachiocephalic arteritis or Martorell's syndrome or pulseless disease), tuberculous arteritis, endarteritis obliterans, arteritis umbilicalis, and verminous mesenteric arteritis. There are different forms of Vascular dementia, including multi-infarct dementia (MID), Binswanger's Disease and Arteriosclerotic Dementia. There is a huge collection of other cardiovascular problems, including thymoma (invasive and non-invasive), admixture lesion, left ventricular hypertrophy, tortuous aorta, aortic laceration pulmonary artery sarcoma, aortic regurgitation, pneumomediastinum (Spontaneous and traumatic), middle mediastinal mass, posterior mediastinal mass, Uhl disease, right ventricular hypertrophy, cardiac rhabdomyoma, acute aortic dissection, pericardial cyst, carotid artery bruit, pulmonary embolism, venous angioma, varicose veins and

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spider veins, congenital heart disease, pericardial effusion, tetralogy of Fallot, coronary artery calcification, endocardial fibroelastosis, fibromuscular dysplasia (FMD), thromboangiitis obliterans (Buerger disease), left or right ventricular volume overload, situs inversus, neonatal heart failure, myocarditis, arteriosclerosis, atherosclerosis, stroke and many others.

(B) The nature of the invention and predictability in the art:

The invention is directed toward medicine and is therefore physiological in nature. It is well established that “the scope of enablement varies inversely with the degree of unpredictability of the factors involved,” and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

(C) Direction or Guidance:

That provided is very limited. The dosage range information, found on page 33 of the Specification gives about 0.01 mg to about 100 mg/day, which is very broad. Moreover, this is generic, the same for the many disorders covered by the specification. Thus, there is no specific direction or guidance regarding a regimen or dosage effective specifically for any and all cardiovascular disorders.

(D) State of the Prior Art:

These compounds are substituted 2,3,4,5-tetrahydrobenzo[b]azepine. So far as the examiner is aware, no substituted 2,3,4,5-tetrahydrobenzo[b]azepine of any kind have been used for inhibiting or treating any and all cardiovascular



diseases.

(E) Working Examples:

The invention is drawn to a method of treating one or more cardiovascular disorders. There are no working examples or even animal models, in the Specification drawn to this utility to support the use of substituted 2,3,4,5-tetrahydrobenzo[b]azepine to treat any and all cardiovascular disorders. On pages 29-32 of the Specification there are several in vitro and in vivo assays presented for the cholesterol ester transfer protein.

(F) Skill of those in the art:

These diseases and disorders disclosed in the Specification on pages 10 cannot be treated generally by any one drug. These are all different diseases and disorders, which occur at different locations and by different modes of action in the body.

(G) The quantity of experimentation needed:

Owing especially to factors A, C, E and F, the amount of experimentation is expected to be high.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright,

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999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” That conclusion is clearly justified here.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 8, 9, 12, 14-16, 18, 20, 22 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claims 1, 8, 9, 14-16, 18, 20, 22 and 26 are vague and indefinite in that it is not known what is meant by the moiety  $\text{-NR}^7\text{R}^8\text{-OC}_1\text{-C}_6\text{alkylaryl}$  in the definition of  $\text{R}^1$ .
- b. Claims 1-5, 8, 9, 14-16, 18, 20, 22 and 26 are vague and indefinite in that it is not known what is meant by the compound  $\text{C}_1\text{-C}_6$  alkylalcohol in the definition of  $\text{R}^5$ .
- c. Claims 1-5, 8, 9, 14-16, 18, 20, 22 and 26 are vague and indefinite in that it is not known what is meant by the definition of  $\text{R}^7$  which is not stated in the form of a proper Markush grouping.
- d. Claim 2 is vague and indefinite in that it is not known what is meant by the comma at the end of the claim indicating that there is more to come. A claim must end with a period.
- e. Claim 3 recites the limitation  $\text{"-OC}_2\text{-C}_6\text{ alkenyl"}$  in the definition of  $\text{R}^1$ . There is insufficient antecedent basis for this limitation in the claim.

- f. Claim 4 is vague and indefinite in that it is not known what is meant by the "and" which appears between the moieties C<sub>1</sub>-C<sub>6</sub> alkylheterocyclic, and C<sub>3</sub>-C<sub>8</sub> cycloalkyl indicating the end of the Markush grouping which is not so.
- g. Claim 4 is vague and indefinite in that it is not known what is meant by the period which appears after the C<sub>3</sub>-C<sub>8</sub> cycloalkyl moiety in the definition of R<sup>1</sup>.
- h. Claim 5 recites the limitation "**y** is a bond" in the first line of the claim.  
There is insufficient antecedent basis for this limitation in the claim.
- i. Claim 5 is vague and indefinite in that it is not known what is meant by "alkycycloalkyl" in the definition of R<sup>1</sup>.
- j. Claim 5 recites the limitation "wherein the alkyl" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.
- k. Claim 5 recites the limitation "hydroxyl, C<sub>1</sub>-C<sub>6</sub> alkylcycloalkyl, C<sub>3</sub>-C<sub>8</sub> cycloalkyl, C<sub>1</sub>-C<sub>6</sub> alkylaryl, aryloxy, -OC<sub>2</sub>-C<sub>6</sub> alkenyl, -OC<sub>1</sub>-C<sub>6</sub> haloalkyl, -OC<sub>3</sub>-C<sub>8</sub> cycloalkyl, and -OC<sub>1</sub>-C<sub>6</sub> alkylaryl" in the definition of the substituents on R<sup>1</sup>.  
There is insufficient antecedent basis for this limitation in the claim.
- l. Claim 8 is vague and indefinite in that it is not known what is meant by the range q is 1-3, where q in claim 1 is defined as 0, 1, 2 or 3 and not the range 0-3.
- m. Claim 12 recites the limitation "2-methyl" in the 13<sup>th</sup> species. There is insufficient antecedent basis for this limitation in the claim.
- n. Claim 12 recites the limitation "benzo[b]azocine" in the 14<sup>th</sup>, 15<sup>th</sup> and 16<sup>th</sup> species. There is insufficient antecedent basis for this limitation in the claim.

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- o. Claim 15 is vague and indefinite in that it is not known what is meant by “Cardiovascular Diseases”. Capital letters are only used at the beginning of the claim and in the case of chemical compounds for variables and/or elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624